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EXAMINER

NARAYANASWAMY, SINDYA

ART UNIT PAPER NUMBER

2154

DATE MAILED: 03/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/525,065

Applicant(s)

YOSHIDA, HIROYOSHI

Examiner

Sindya Narayanaswamy

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 8/02/2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. Claims 1 – 13 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. The abstract of the disclosure is objected to because the words “means” is inappropriate to use (lines 4-7, 9, 10-13). Correction is required. See MPEP § 608.01(b).

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- ~ (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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5. Claims 1, 5, and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Giltner et al, US-4,386,416.

6. As per claim 1, Giltner et al. teach the invention as claimed including a data transmission apparatus comprising:

input means for inputting data (compression unit) (Abstract, line 4);

transmission means for transmitting the data input by said input means (compression unit) (Abstract line 4);

discrimination means for discriminating an attribute of the data input by said input means (136, Fig. 3);

and control means for controlling a transmission operation by the transmission means in accordance with a discrimination result by said discrimination means, wherein said control means controls a transmission route of the data input by said input means in accordance with the discrimination result by said discrimination means (Abstract, lines 14-21).

7. As per claim 5, Giltner et al teach a data transmission apparatus comprising:

input means for inputting data (compression unit) (Abstract, line 4);

transmission means for transmitting the data input by the input means to a destination (compression unit) (Abstract line 4);

discrimination means for discriminating the destination (col. 17, lines 13-18) and

control means for controlling a transmission operation by the transmission means in

accordance with a discrimination result by the discrimination means wherein the control

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means controls a transmission route of the data input by the input means in accordance with the discrimination result by the discrimination means (152, Fig. 3; col. 7, lines 15-36).

8. As per claims 10 and 12, they are the method and computer-readable program claims of claim 1; therefor they are rejected on the same basis as claim 1.

9. As per claims 11 and 13, they are the method and computer-readable program claims of claim 5; therefore they are rejected on the same basis as claim 5.

10. Claims 1, 4, 10, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Maki, US-5,774,654.

11. As per claim 1, Maki teaches the invention as claimed including a data transmission apparatus comprising (Fig. 1; col 1, lines 65-67; col. 2, lines 30-44):

input means for inputting data (9, Fig. 1; col. 1, lines 30-44);

transmission means for transmitting the data input by said input means (S14, S15, Fig. 2; col 2., lines 1-4; col. 3, lines 21-29);

discrimination means for discriminating an attribute of the data input by said input means (col. 1, lines 37-43);

and control means for controlling a transmission operation by said transmission means in accordance with a discrimination result by said discrimination means, wherein said control

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means controls a transmission route of the data input by said input means in accordance with the discrimination result by said discrimination means (col. 1, lines 32-57).

12. As per claim 4, Maki teaches the discrimination means discriminates a data amount of the data input by said input means (Fig. 5; col. 4, lines 40-50).

13. As per claim 10, it is the method claim of claim 1 and it is rejected on the same basis as claim 1.

14. As per claim 12, it is the computer-readable program claim of claim 1, and it is rejected on the same basis as claim 1.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5, 11 and 13 are rejected under 35. U.S.C 103(a) as being unpatentable over Maki, US-5,774,654.

3. As per claim 5, Maki teaches a data transmission apparatus comprising (Fig. 1; col. 1, lines 65-67; col. 2, lines 30-44):

input means for inputting data (9, Fig. 1; col. 1, lines 30-44);

transmission means for transmitting the data input by said input means to a destination (S14, S15, Fig. 2; col 2., lines 1-4; col. 3, lines 21-29);

Discrimination means (col. 1, lines 37-43); and control means for controlling a transmission operation by said transmission means in accordance with a discrimination result by said discrimination means wherein said control means controls a transmission route of the data input by said input means in accordance with the discrimination result by said discrimination means (col. 1, lines 32-57).

4. Maki does not specifically that the discrimination means is for discriminating the destination. However, Maki discloses that his system will determine the number of channels used for data communication based on the type of data (col. 3, lines 18-20) it would have been obvious to one skilled in the art at the time the invention was made to incorporate the destination in Maki's system because it would have improved the optimal performance of Maki's destination in receiving the data. One skilled in the art would have been motivated to do so in order to improve the performance of Maki's system (col. 1, lines 20-25).

5. As per claims 11 and 13, they are the method and computer readable program claims of claim 5; therefore they are rejected on the same basis as claim 5.

6. Claims 2, 3 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maki, US-5,774,654, in view of Birrell et al, US-5,774,654.

7. As per claim 2, Maki did not specifically teach that a control means switches a mode to directly transmit the data input by said input means to a destination and a mode to store said data to a predetermined location and hand it to the destination in accordance with the discrimination result by said discrimination means. Birrell et al teach an apparatus wherein said control means switches a mode (hold-back) to directly transmit the data input by said input means to a destination and a mode to store said data to a predetermined location and hand it to the destination in accordance with the discrimination result by said discrimination means (col. 12, lines 59-67; col. 13; lines 1-7).

8. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Maki and Birrell et al because Birrell's system of storing data allows for the receiver to access data that could not be otherwise viewed by placing it in an alternate location. One of ordinary skill in the art at the time of the invention would have been motivated to do so in order to improve the quality of the transmission system.

9. As per claim 3, Birrell et al teach a system wherein in the case where the data input by said input means is handed to the destination (components), said transmission means transmits a

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message indicative (hot-links) of an access manner of the data to the destination (col. 13; lines 1-7).

10. As per claim 6, Birrell et al teach a system wherein discrimination means discriminates (filtered and controlled) a connecting format to the destination (col. 5, lines 63-67; col. 6, lines 18).

11. As per claim 7, Maki and Birrell et al do not teach an apparatus wherein said discrimination means discriminates a processing ability of a device of the destination. However, Birrell et al disclosed that the system can be configured to "hold-back" large embedded components and replace them with hot-links. It would have been obvious to one of ordinary skill in the art to configure the system to "hold-back" when it is required. One of ordinary skill in the art would have been motivated to do so because it would minimize an unnecessary amount of network traffic and thus improve user interactions. One of ordinary skill in the art at the time of the invention would have been motivated to do so in order to improve the quality of the transmission system.

12. As per claim 8, it is rejected on the same basis as claims 2 and 5.

13. As per claim 9, it is rejected on the same basis as claims 3 and 5.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- a. "Method and Apparatus for Transmitting Electronic Mail Attachments With Attachment References," Beck et al, US-5,903,723.
- b. "Method and Apparatus for Determining a Data Transmission Capacity Between Communicatively Connected Source And Target Devices," Ventura, US-6,321,283.
- c. "Internetwork Address Mapping Gateway," Gervais et al., US-5,856,974.
- d. "Congestion Control For High Speed Packet Networks," Doshi et al, US-5,291,481.
- e. "System For Expediting The Clearing of Financial Instruments and Coordinating the same with Invoice Processing At the Point of Receipt," Geer, US-5,930,778.
- f. "Store and Forward Type of Text Processing Unit," Kuseki, US-4,330,847.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sindya Narayanaswamy whose telephone number 703-305-8473. The examiner can normally be reached on 8 am to 5 pm, first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703) 305-9678. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5404 for regular communications and (703) 305-5404 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

March 21, 2003

Sindya Narayanaswamy

  
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